

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant:	<b>Richard HULL et al.</b>	)	Examiner:	Wayne Huu CAI
		)		
Serial No.:	<b>10/635,925</b>	)	Art Unit:	2681
		)		
Filed:	August 5, 2003	)	Our Ref:	B-5190 621139-0
		)		300204853-2 US
For:	"RETRIEVING MEDIA ITEMS TO A	)		
	MOBILE DEVICE"	)	Date:	January 20, 2008
		)		
		)	Re:	<i>Appeal to the Board of Appeals</i>

**BRIEF ON APPEAL**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is an appeal from the rejection dated August 22, 2007, for the above identified patent application. This Appeal Brief is being timely filed in support of the Notice of Appeal filed on November 20, 2007. The amount of \$500.00 for the fee set forth in 37 C.F.R. 1.17(c) has been paid in connection with the Appeal previously filed on July 6, 2006. Please deduct the amount of \$10, for the difference between the previously paid amount and the fee currently set forth in 37 C.F.R. 1.17(c) for submitting this Brief, from deposit account no. 08-2025.

**REAL PARTY IN INTEREST**

The real party in interest to the present application is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

### **RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences related to the present application.

### **STATUS OF CLAIMS**

Claims 1-7, 9-22, and 24-30 are pending in this application, stand rejected, are the subject of this Appeal, and are reproduced in the accompanying appendix. Claims 8, 23, and 31-32 have been canceled without prejudice.

### **STATUS OF AMENDMENTS**

No Amendment After Final Rejection has been entered.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

The invention claimed in claim 1 is directed to a method of retrieving a data item to a mobile device (31) carried by a first user (30) visiting a real-world space (10), the data item being available from a service system (35) to mobile devices of users visiting the space, the method comprising (a) keeping a record on an on-going basis of which mobile devices in said space, if any, hold or are likely to be holding the data item; (b) seeking to retrieve the data item to the first user's mobile device by requesting transfer only from mobile devices that, according to said record, hold or are likely to be holding the data item; and (c) in the event that (b) is unsuccessful, retrieving the data item to the first user's mobile device by transfer from the service system (p. 10 l. 16 – p. 12 l. 11, Figs. 1-6).

The invention claimed in claim 14 is directed to a method of retrieving a data item to a mobile device (31) carried by a first user (30) visiting a real-world space (10), the data item being one of a plurality of data items available from a service system (35) to mobile devices of users visiting the space, each one of said plurality of data items having a respective associated location in said space, the method comprising (a) seeking to retrieve the data item to the first user's mobile device by transfer from another mobile device in said space; and (b) in the event that (a) is unsuccessful, retrieving the data item to the first user's mobile device by transfer from the service system; the method further comprising an on-going process in which said space is treated as divided into zones and, for each zone, upon a mobile device exiting the zone, it

transfers the data items it holds that have associated locations in the zone being exited to devices, if any, still in said zone to increase the likelihood of (a) being successfully effected from a mobile device in the same zone as the first-user's mobile device (p. 10 l. 16 – p. 12 l. 11, Figs. 1-6).

The invention claimed in claim 16 is directed to an arrangement for retrieving a data item to a mobile device (31) carried by a first user (30) visiting a real-world space (10), the data item being available from a service system (35) to mobile devices of users visiting said space, the arrangement comprising record means for keeping an on-going record of which mobile devices, if any, hold or are likely to be holding the data item; first retrieval means for seeking to retrieve the data item to the first user's mobile device by transfer from another mobile device and including enquiry means for carrying out an enquiry limited to mobile devices that, according to said record, hold or are likely to be holding the data item; second retrieval means for retrieving the data item to the first user's mobile device by transfer from the service system; and control means for organising retrieval of the data item by first causing the first retrieval means to seek to retrieve the data item and then, if this is unsuccessful, causing the second retrieval means to retrieve the data item (p. 8 l. 28 – p. 10 l. 4, Figs. 1-6).

The invention claimed in claim 29 is directed to an arrangement for retrieving a data item to a mobile device (31) carried by a first user (30) visiting a real-world space (10), the data item being one of a plurality of data items available from a service system (35) to mobile devices of users visiting the space, each one of said plurality of data items having a respective associated location in said space, the arrangement comprising first retrieval means for seeking to retrieve the data item to the first user's mobile device by transfer from another mobile device; second retrieval means for retrieving the data item to the first user's mobile device by transfer from the service system; control means for organising retrieval of the data item by first causing the first retrieval means to seek to retrieve the data item and then, if this is unsuccessful, causing the second retrieval means to retrieve the data item; and transfer means for executing an on-going process in which said space is treated as divided into zones and, for each zone, upon a mobile device exiting the zone, it transfers the data items it holds that have associated locations in the zone being exited to devices, if any, still in said zone to increase the likelihood of the data item

being successfully retrieved from a mobile device in the same zone as the first-user's mobile device (p. 8 l. 28 – p. 10 l. 4, Figs. 1-6).

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

**Issue 1:** Whether claims 1-7, 9-22, and 24-30 are indefinite in view 35 U.S.C. 112, second paragraph.

### **ARGUMENT**

**Issue 1: Whether claims 1-7, 9-22, and 24-30 are indefinite in view 35 U.S.C. 112, second paragraph.**

In the final Office Action of April 6, the Examiner once again rejects claims 1-7, 9-22, and 24-30 under 35 U.S.C. §112 for reciting “likely to be holding” which, the Examiner insists, allegedly render the claims indefinite. More specifically, the Examiner reiterates his opinion that this phrase “could render the claim indefinite because the mobile device is not necessarily holding any data item. More importantly, the Applicant’s specification does not specify how “likely” to consider that the mobile device is likely to be holding the data item.” In their latest submission, Appellants respectfully disagreed.

Specifically, Appellants explained that there is nothing indefinite about the objected-to phrase precisely because the Examiner’s interpretation is correct: “likely to be holding” means that the mobile device is not necessarily holding any data item. Rather, as the claim language clearly sets forth, the mobile device must only *be likely* to be holding the data item. This is a simple and well understood term of the English language:

**likely:** *adj.* Having a chance of happening or being true.

The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2007, 2000 by Houghton Mifflin Company.

Appellants thus submitted that this is precisely the scope of the claim - keeping a record on an on-going basis of which mobile devices in said space, if any, hold or have a chance of holding the data item. This is indeed one of the inventive notions in the claimed invention - also

keeping track of those mobile devices which *are likely*, or *have a chance*, or *might*, be holding the data item, not just those that actually do hold the item. There is nothing indefinite about this term.

As for the Examiner's objection that the specification does not specify *how likely* a mobile device must be of holding the data item, Appellants submitted that there is absolutely no requirement for such a hard numerical range to be specified - after all, the inventive genius does not revolve on how likely a device is to hold the data item but rather the very notion of also tracking devices that are likely to be holding in addition to those actually holding the data item. Those skilled in the art can certainly decide for themselves, without undue experimentation, how likely they want a device to be holding in order to keep track of it in their particular implementation of Appellants' invention and Appellants respectfully requested the Examiner to provide supporting documentation for his assertion that this term would befuddle one skilled in the art of mobile cellular telecommunications, should he insist on this point of view.

In the present, final Action, the Examiner does indeed persist in this point of view, but offers nothing new in support thereof beyond more convenient, declarative assertions such as "...one skilled in the art would not be able to ascertain how or which mobile is considered as one that is likely to be holding the data item." Appellants respectfully invite the Board to peruse the Examiner's response to arguments for any whiff of an explanation as to why a person skilled in the design of cellular telecommunication circuitry would not be able to devise a scheme for ascertaining which mobile devices are likely to be holding the data item of interest, especially when the claims themselves provide guidance to at least one such scheme. Claim 10, *inter alia*, teaches the skilled and careful reader that said on-going record keeping of which mobile devices are likely to be holding the data item comprises at least the first one of periodically making an inventory of items currently held by each mobile device and recording incremental changes to the inventory of each mobile devices as items are added/removed. The Examiner apparently believes that this would not suffice for a person having at least a degree in electrical engineering unless it is accompanied by some hard, numerical range for the tracked likelihood. Appellants respectfully submit that this is not a reasonable conclusion.

The Examiner further declares that "it is also clear to the Examiner that the Applicants

are uncertain at the moment or at the time of the invention to determined, define, or even decide how likely is reasonably considered as 'likely to be holding the data item.'" This convenient and far reaching pronouncement is equally devoid of any support or explanation - apparently the Examiner considers his personal opinion to amount to legal justification simply by virtue of being his personal opinion. Appellants respectfully insist that this is not quite so:

[T]he examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (*examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure*). ... As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971) (emphasis added).

...This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. ... specific technical reasons are always required.

MPEP 2164.04

Appellants respectfully submit that the Examiner has made no specific findings of fact, offered no specific technical reasons, nor provided any explanation, much less a reasonable one. The only statement offered by the Examiner that could possibly be understood as explaining his rejection is the *non-sequitur*

One skilled in the art could easily conceptualize that "likely to be holding" means that there is a chance that the mobile [is?] holding the data item, but it also means that it does not hold truth at all times, and there is a chance that the mobile is not holding the data item.

Appellants respectfully submit that this is simply illogical. The fact that there may be "a chance that the mobile is not holding the data item" simply means that the probability of the mobile holding the data item is less than one. How does this have anything to do with the ability of the skilled person to ascertain whether the mobile has a chance of holding the item that is greater than zero? Appellants submit that the Examiner's above reasoning abundantly proves that

he is clearly confused by this simple notion as he keeps interchanging the rather simple but separate and different concepts of “a chance of holding the item” and “not necessarily holding the data item.”

Appellants respectfully submit that the objected-to term “likely to be holding” speaks to the very inventiveness of the presently claimed inventions and that one skilled in the art would not in fact find this term indefinite, and thus request the Board to kindly consider the above and overturn the Examiner’s rejection of the claims on appeal and pass the case to allowance.

### CONCLUSION

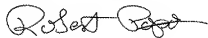
For the many reasons advanced above, Appellants respectfully contend that each claim is patentable and reversal of all rejections and allowance of the case is respectfully solicited.

I hereby certify that this document is being transmitted to the  
Patent and Trademark Office via electronic filing.

January 20, 2008

(Date of Transmission)

Respectfully submitted,



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Attachments

**CLAIMS APPENDIX**

1. A method of retrieving a data item to a mobile device carried by a first user visiting a real-world space, the data item being available from a service system to mobile devices of users visiting the space, the method comprising:

(a) keeping a record on an on-going basis of which mobile devices in said space, if any, hold or are likely to be holding the data item;

(b) seeking to retrieve the data item to the first user's mobile device by requesting transfer only from mobile devices that, according to said record, hold or are likely to be holding the data item; and

(c) in the event that (b) is unsuccessful, retrieving the data item to the first user's mobile device by transfer from the service system.

2. A method according to claim 1, wherein the data item is associated with a location in said space, (b) being initiated as the user approaches or is at that location and including carrying out an enquiry limited to mobile devices that are, or are likely to be, near the first user or said location, to identify a mobile device, if any, holding the data item.

3. A method according to claim 2, wherein said enquiry is limited to mobile devices near the mobile device of the first user by having that device make the enquiry by using a short-range communications means to ask other mobile devices if they have the data item.



4. A method according to claim 2, wherein said enquiry is limited to mobile devices near the mobile device of the first user or near the location associated with the data item, by monitoring the locations of the mobile devices in said space.

5. A method according to claim 2, wherein said enquiry is limited to mobile devices likely to be near the mobile device of the first user by pre-defining a set of mobile devices which are associated with users belonging to the same visit group.

6. A method according to claim 2, wherein in (b) said enquiry is carried out by the first user's mobile device.

7. A method according to claim 2, wherein in (b) said enquiry is carried out by the service system at the prompting of the first user's mobile device, the service system identifying back to the first user's mobile device at least one device holding the data item where the enquiry identifies any such device.

9. A method according to claim 1, wherein said on-going record keeping comprises tracking at least the first one of:

transfers of the data item from the service system to a mobile device;

transfers of the data item between mobile devices; and

deletions of the data item from a mobile device.

10. A method according to claim 1, wherein said on-going record keeping

comprises at least the first one of:

periodically making an inventory of items currently held by each mobile device;  
and

recording incremental changes to the inventory of each mobile devices as items  
are added/removed.

11. A method according to claim 1, wherein in (b) said enquiry is carried out by the  
first user's mobile device.

12. A method according to claim 1, wherein in (b) said enquiry is carried out by the  
service system at the prompting of the first user's mobile device, the service system  
identifying back to the first user's mobile device at least one device holding the data  
item where the enquiry identifies any such device.

13. A method according to claim 1, wherein multiple data items each with a  
respective associated location in said space are available from the service system, the  
method further comprising an on-going process in which said space is treated as  
divided into zones and, for each zone, the service system causes the mobile devices in  
the zone to load data items associated with locations in that zone beyond the normal  
needs of the devices whereby to increase the likelihood of (b) being successfully  
effected from a mobile device in the same zone as the first-user's mobile device.

14. A method of retrieving a data item to a mobile device carried by a first user  
visiting a real-world space, the data item being one of a plurality of data items  
available from a service system to mobile devices of users visiting the space, each one

of said plurality of data items having a respective associated location in said space, the method comprising:

(a) seeking to retrieve the data item to the first user's mobile device by transfer from another mobile device in said space; and

(b) in the event that (a) is unsuccessful, retrieving the data item to the first user's mobile device by transfer from the service system; the method further comprising

an on-going process in which said space is treated as divided into zones and, for each zone, upon a mobile device exiting the zone, it transfers the data items it holds that have associated locations in the zone being exited to devices, if any, still in said zone to increase the likelihood of (a) being successfully effected from a mobile device in the same zone as the first-user's mobile device.

15. A method according to claim 1, wherein a transfer effected in (a) is effected using a communications mechanism that is different to that used for a transfer effected in (b).

16. An arrangement for retrieving a data item to a mobile device carried by a first user visiting a real-world space, the data item being available from a service system to mobile devices of users visiting said space, the arrangement comprising:

record means for keeping an on-going record of which mobile devices, if any, hold or are likely to be holding the data item;

first retrieval means for seeking to retrieve the data item to the first user's mobile device by transfer from another mobile device and including enquiry means for carrying out an enquiry limited to mobile devices that, according to said record, hold or are likely to be holding the data item;

second retrieval means for retrieving the data item to the first user's mobile

device by transfer from the service system; and

control means for organising retrieval of the data item by first causing the first retrieval means to seek to retrieve the data item and then, if this is unsuccessful, causing the second retrieval means to retrieve the data item.

17. An arrangement according to claim 16, wherein the data item is associated with a location in said space, the arrangement including means responsive to the user approaching that location to cause the control means to initiate retrieval of the data item, and the first retrieval means including enquiry means for carrying out an enquiry limited to mobile devices that are, or are likely to be, near the first user or said location, to identify a mobile device, if any, holding the data item.

18. An arrangement according to claim 17, wherein the first retrieval means includes short-range communication means forming part of said first user's mobile device, the enquiry means being arranged to use said short-range communications means to ask other mobile devices if they have the data item whereby inherently to limit its enquiry to mobile devices near the mobile device of the first user.

19. An arrangement according to claim 17, wherein said arrangement includes location means for obtaining the locations of the mobile devices in said space, the enquiry means being arranged to use the device locations obtained by the location means to limit its enquiry to mobile devices near the mobile device of the first user or near the location associated with the data item.

20. An arrangement according to claim 17, wherein said arrangement includes set-

defining means for pre-defining a set of mobile devices which are associated with users belonging to the same visit group, the enquiry means being arranged to limit its enquiry to mobile devices likely to be near the mobile device of the first user by making its enquiry only to devices which, according to said set-defining means, are members of said set.

21. An arrangement according to claim 17, wherein said enquiry means is part of the first user's mobile device.

22. An arrangement according to claim 17, wherein the enquiry means is part of the service system and the first retrieval means further includes means at the first user's mobile device for prompting the enquiry means to carry out its enquiry and identify back to the first user's mobile device at least one device holding the data item where the enquiry identifies any such device.

24. An arrangement according to claim 16, wherein said record means is arranged to track at least the first one of:

transfers of the data item from the service system to a mobile device;

transfers of the data item between mobile devices; and

deletions of the data item from a mobile device.

25. An arrangement according to claim 16, wherein said record means is arranged to carry out at least the first one of:

periodically making an inventory of items currently held by each mobile device;  
and

recording incremental changes to the inventory of each mobile devices as items  
are added/removed.

26. An arrangement according to claim 16, wherein said enquiry means is part of  
the first user's mobile device.

27. An arrangement according to claim 16, wherein the enquiry means is part of the  
service system and the first retrieval means further includes means at the first user's  
mobile device for prompting the enquiry means to carry out its enquiry and identify  
back to the first user's mobile device at least one device holding the data item where  
the enquiry identifies any such device.

28. An arrangement according to claim 16, wherein multiple data items each with a  
respective associated location in said space are available from the service system, the  
arrangement further comprising location means for monitoring the locations of the  
mobile devices, and a zone-based manager that is arranged to treat said space as  
divided into zones and, for each zone, to cause the mobile devices in the zone to load  
data items associated with locations in that zone beyond the normal needs of the  
devices whereby to increase the likelihood of the first retrieval means being successful  
in seeking to retrieve said data item from a mobile device in the same zone as the first-  
user's mobile device.

29. An arrangement for retrieving a data item to a mobile device carried by a first

user visiting a real-world space, the data item being one of a plurality of data items available from a service system to mobile devices of users visiting the space, each one of said plurality of data items having a respective associated location in said space, the arrangement comprising:

first retrieval means for seeking to retrieve the data item to the first user's mobile device by transfer from another mobile device;

second retrieval means for retrieving the data item to the first user's mobile device by transfer from the service system;

control means for organising retrieval of the data item by first causing the first retrieval means to seek to retrieve the data item and then, if this is unsuccessful, causing the second retrieval means to retrieve the data item; and

transfer means for executing an on-going process in which said space is treated as divided into zones and, for each zone, upon a mobile device exiting the zone, it transfers the data items it holds that have associated locations in the zone being exited to devices, if any, still in said zone to increase the likelihood of the data item being successfully retrieved from a mobile device in the same zone as the first-user's mobile device.

30. An arrangement according to claim 16, wherein the first and second retrieval means are arranged to use different respective communication mechanisms for effecting retrieval of said data item.

**EVIDENCE APPENDIX**

There is no evidence submitted with the present Brief on Appeal.



**RELATED PROCEEDINGS APPENDIX**

There are no other appeals or interferences related to the present application.